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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,969	07/26/2001	Rodney D. Cambridge	NETAP016	9329
28875	7590	02/16/2005	EXAMINER	
Zilka-Kotab, PC P.O. BOX 721120 SAN JOSE, CA 95172-1120			POPHAM, JEFFREY D	
			ART UNIT	PAPER NUMBER
			2137	

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/916,969

Applicant(s)

CAMBRIDGE, RODNEY D. ET AL.

Examiner

Jeffrey D. Popham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) 17-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-11 and 13-15 is/are rejected.
- 7) ☒ Claim(s) 3,4,12 and 16 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20020227</u> . | 6) <input type="checkbox"/> Other: ____ |

Remarks

Claims 1-56 are pending.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-16, drawn to responding to a virus alert, classified in class 713, subclass 200.
- II. Claims 17-46, drawn to predicting the incidence of a virus in a computer system, classified in class 713, subclass 200.
- III. Claims 47-54, drawn to protecting a system against a virus, classified in class 713, subclass 200.

Inventions I, II, and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable.

- In the instant case, invention II has separate utility from invention III such as use in a system where the anti-virus application runs sequentially after predicting the incidence of a virus.
- In the instant case, invention I has separate utility from invention III such as use in a system where an anti-virus application is not downloaded until the prediction of incidence of a virus is high enough to warrant the running of such an application.

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- In the instant case, invention I has separate utility from invention II such as for use with a system that uses a different method of assessing when to obtain program code to combat the new virus.

See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and the search required for Group I contains the classification 709/220 which is not required for Groups II and III, the search for Group II contains the classification 714/723 which is not required for Groups I and III, and the search required for Group III contains the classification 713/188 which is not required for Groups I and II, restriction for examination purposes as indicated is proper.

2. Claims 17-56 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement during a telephone interview on 02/08/2005.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description:

- Figure 1: 106, 108, 114
- Figure 5: 404

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Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claims 4, 5, and 14 are objected to because of the following informalities:

- Claim 3, line 4: "the infection" should be "the previous infection".
- Claim 11, line 4: "an infection" should be "a previous infection".
- Claim 11, line 6: "the infection" should be "the previous infection".
- Claim 12, lines 3 and 4: "the infection" should be "the previous infection".
- Claim 15, line 4: "an infection" should be "a previous infection".
- Claim 15, line 6: "the infection" should be "the previous infection".
- Claim 16, lines 3 and 4: "the infection" should be "the previous infection".

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Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 3, 4, 10, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms "relatively significant damage", "significant risk", and "substantially combat" in claim 1 are relative terms that render the claim indefinite. The terms "damage", "risk", and "combat" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The terms "relatively long duration", "relatively significant scope", "significant risk", and "relatively significant damage" in claim 5 are relative terms that render the claim indefinite. The terms "duration", "scope", "risk", and "damage" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

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The terms "significant new infection", "significant risk", and "substantially combat" in claim 10 are relative terms that render the claim indefinite. The terms "new infection", "risk", and "combat" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The terms "relatively significant infection", "significant risk", and "substantially combat" in claim 14 are relative terms that render the claim indefinite. The terms "infection", "risk", and "combat" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 5-11, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill et al. (U.S. Patent 6,088,804) in view of Hodges et al. (U.S. Patent 6,035,423).

Regarding Claim 1,

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Hill et al. disclose a method comprising:

Assessing a risk level associated with the new virus, the risk level indicating a risk of significant damage cause by an infection of the new virus on a computer system (Column 6, lines 9-51); and

Obtaining a program code when the risk level indicates that the new virus may pose a significant risk of significant damage on the computer system, the program code being configured to substantially combat the new virus (Column 8, line 62 through Column 9, line 33).

Hill et al. do not disclose receiving a virus alert.

Hodges et al., however, disclose a method for responding to a virus alert, the virus alert containing information pertaining to a new virus, the method comprising receiving the virus alert (Column 7, lines 40-60). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to combine Hill et al.'s system for assessing virus risks with Hodge et al.'s system for updating virus information in order to alert the user that new virus files are ready to be used and the files on the user's system are outdated.

Regarding Claim 10,

Claim 10 is a computer program product claim that is substantially equivalent to method claim 1. Therefore, claim 10 is rejected under a similar rationale.

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Regarding Claim 14,

Claim 14 is a system claim that is substantially equivalent to method claim 1. Therefore, claim 14 is rejected under a similar rationale.

Regarding Claim 2,

Hill et al. disclose that assessing the risk level associated with the new virus includes:

Obtaining information associated with at least one previous virus which has caused a previous infection on the computer system (Column 8, lines 39-48); and

Comparing the information pertaining to the new virus with the information associated with the previous virus which has previously caused the previous infection on the computer system (Column 8, lines 39-48).

Regarding Claim 11,

Claim 11 is a computer program product claim that is substantially equivalent to method claim 2. Therefore, claim 11 is rejected under a similar rationale.

Regarding Claim 15,

Claim 15 is a system claim that is substantially equivalent to method claim 2. Therefore, claim 15 is rejected under a similar rationale.

Regarding Claim 5,

The information associated with the previous virus which has caused a previous infection on the computer system is stored in a profile on a database associated with the computer system (Column 5, lines 38-51).

Regarding Claim 6,

Hill et al. and Hodges et al. disclose the method of claim 1, in addition Hodges et al. disclose that the virus alert is received from an anti-virus information source (Column 7, lines 40-42).

Regarding Claim 7,

Hill et al. and Hodges et al. disclose the method of claim 6, in addition Hodges et al. disclose that the virus alert is automatically received from the anti-virus information source (Column 7, lines 42-43).

Regarding Claim 8,

Hill et al. and Hodges et al. disclose the method of claim 6, in addition Hodges et al. disclose that receiving the virus alert includes acquiring the virus alert from the anti-virus information source (Column 7, lines 40-43).

Regarding Claim 9,

The computer system is a computer network, the computer network including a plurality of computing devices (Column 4, lines 5-10).

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6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hill et al. in view of Hodges et al., further in view of Hallman et al. (U.S. Patent 6,393,424).

The combination of Hill et al. and Hodges et al. does not teach the group from which the computer-readable medium is made up of.

Hallman et al., however, teach that the computer-readable medium is one selected from a group consisting of a hard disk, a CD-ROM, a DVD, a computer disk, a tape drive, a computer memory, and a data signal embodied in a carrier wave (Column 2, line 66 to Column 3, line 10). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use this group of computer-readable media in order to allow the code to be store on a wide variety of such media.

Allowable Subject Matter

7. Claims 3, 4, 12, and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 3,

The prior art fails to specifically teach the combination of duration of a prior infection and scope of the prior infection being used to assess the risk level. The closest prior art, Hill et al., does teach that the previous virus and the new virus are of a first type

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(Column 5, lines 38-44) and that the information associated with the previous infection includes the scope of the infection (Column 5, lines 45-41), but does not disclose the duration of the prior infection being used for the same purpose.

Regarding Claims 12 and 16,

Claims 12 and 16 are computer program product and system claims, respectively, that are substantially equivalent to method claim 3. Therefore, the reasons for indication of allowable subject matter are the same as for claim 3.

Regarding Claim 4,

The prior art fails to specifically teach the combination of a long duration of a prior infection and a large scope of the prior infection being used to assess the new infection of the same type as being of high risk. The closest prior art, Hill et al., does teach that a large scope of the prior infection will be a factor in determining a high risk level of the new infection, but does not disclose the duration of the prior infection having an effect upon the assessment of risk level.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Popham whose telephone number is (571)-272-7215. The examiner can normally be reached on M-F 9:00-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571)-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER